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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Marcin KROTKIEWSKI

Serial No.: 10/585,546

Filed: March 2, 2009

For: FORMULATION FOR TREATING
OBESITY AND ASSOCIATED
METABOLIC SYNDROMERECEIVED
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AUG 16 2010

Group Art Unit 1655

Examiner: S. Hoffman

RESPONSE TO ELECTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated June 16, 2010 (Paper No./Mail Date 20100615), in which the examiner imposed a restriction requirement, applicant provisionally elects, with traverse, for prosecution on the merits the invention identified in the Office Action as "Group I, claim(s) 1-8 and 17, drawn to a formulation comprising green tea extract, Coleous forskholii extract, yerba mate extract and Betula alba extract."

In addition to the restriction requirement, the examiner also imposed a requirement for an election of species based upon the unity of invention requirement and the extraction methods for preparing the green tea extract as claimed in claims 3, 4, 11, or 12. In response to that election of species requirement, applicant provisionally elects, with traverse, the species claimed in

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claim 3. The claims readable on the provisionally elected species are claims 1, 3, 5, 6, and 7.

Reconsideration and withdrawal of the restriction requirement is respectfully requested. It should be noted at the outset that the present application is not a regular U.S. national application under 35 USC 111 but is, instead, a PCT U.S. national stage application that was filed under 35 U.S.C. 371. And for such applications: "Examiners are reminded that unity of invention (not restriction practice pursuant to 37 CFR 1.141-1.146) is applicable in international applications (both Chapter I and II) and in national stage applications submitted under 35 U.S.C. 371," and that "A group of inventions is considered linked to form a single inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature...." (MPEP 1893.03(d)).

It is urged that independent claims 1 and 9 in the present application are each sufficiently linked by a common technical relationship as to constitute a single inventive concept, and that they therefore satisfy the unity of invention requirement. Each of those claims includes common constituents that serve as the link to form a common technical relationship that constitutes a single inventive concept.

The examiner referred to claim 1 of the published Maes et al. application (US 2008/0213202 A1) and suggested that claim 1 of that application identifies several of the constituents recited in claims 1 and 9 of the present application. However, it is important to note that the Maes et al. publication is directed to an entirely different invention, one directed to "A composition for topical application to

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the skin," for the "prevention of dry skin, and associated chrono/proto-aging conditions," and for the "prevention of irritation on the skin, in the treatment and prevention of UV-related damage to the skin, and in the enhancement of the retention of self-tanning." (Maes et al., Abstract). In distinct contrast with the Maes et al. invention, the present invention is not directed to a topical composition for application to the skin for skin-related problems, but is, instead, directed to "A formulation of vegetable extracts for treating obesity and associated metabolic syndrome," an entirely different invention.

The formulation of the present invention is not for external topical application to the skin as is the product disclosed in the Maes et al. publication, but is intended to be ingested (see, e.g., disclosures in specification paragraphs [0029], [0048], [0079], and [0088]). The different physical problems to which the formulation of the Maes et al. publication and those of the present invention are directed, the different methods of utilization of those formulations by the body, and the differences between the respective formulations themselves all join to clearly demonstrate that the Maes et al. publication is not prior art as to the present invention as claimed, and therefore the Maes et al. publication and the present application are each directed to entirely different inventive concepts. And because of those different inventive concepts, the Maes et al. publication does not support a conclusion of an absence of unity of invention of the invention as it is claimed in independent claims 1 and 9 of the present application.

Additionally, the International Searching Authority considered the corresponding PCT application (PCT/SE2006/000552) and it found no lack of unity

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of invention. It is that PCT application upon which the present U.S. national phase application is based, and that PCT application included claims that correspond in scope with the claims in the present national phase application. That conclusion by the International Searching Authority of unity of invention is reflected in the PCT International Preliminary Report on Patentability that issued relative to the corresponding PCT application, a copy of which report was submitted as an attachment to the INFORMATION DISCLOSURE STATEMENT that accompanied the present application upon filing. That patentability report shows that Box No. V on the first page, indicative of a finding of lack of unity of invention, is not marked.

In view of the foregoing, it is respectfully requested that the restriction requirement be reconsidered and that it be withdrawn. The claims in the present application are directed to a single general inventive concept that is a different invention from that disclosed in the Maes et al. published application, the claims therefore do involve a different inventive concept and there is unity of invention reflected in the claims of the present application, and therefore all the claims in the present application are entitled to be considered on the merits without restriction.

With regard to the election of species requirement, it is first believed that the consideration of each of the claims directed to extraction techniques would not impose an undue search burden, as any possibly relevant art would likely be similarly classified. Moreover, the election of species requirement does not implicate a unity of invention determination. In any event, the extraction-step-containing claims are linked by a single inventive concept because they depend from a common independent claim, and there is a clear technical relationship

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between them that involves the corresponding technical feature of a method for obtaining a green tea extract.

Finally, it is believed that the unity of invention requirement does not apply to dependent claims. As expressed in MPEP §1850: (page 1800-99)

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and *not the dependent claims....*

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

MPEP, page 1800-99 (Emphasis added).

In view of the foregoing, it is respectfully requested that the election of species requirement be withdrawn and that at least all the provisionally elected Group I claims be examined on the merits together if the restriction requirement is maintained. Otherwise, all the claims in this application are believed to be properly examinable on the merits.

Early and favorable action on the merits of this application is respectfully requested. The examiner is cordially invited to telephone the undersigned attorney if this response raises any questions.

Respectfully submitted,



Alfred J. Mangels
Reg. No. 22,605
4729 Cornell Road
Cincinnati, Ohio 45241
Telephone: (513) 469-0470

August 14, 2010